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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,659	08/31/2001	Christopher A. Mesa	10017722-1	1784

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EXAMINER

CHUONG, TRUC T

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,659

Applicant(s)

MESA ET AL

Examiner

Truc T. Chuong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to the Appeal Brief, filed 04/28/05.
2. Claims 23-31 are pending in this application. Claims 23, 27, 28, and 31 are independent claims. This action is made non-final.
3. In view of the Appeal Brief filed on April 28, 2005, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "may be selected" in claims 23, 27-28, and 30-31 is a relative term which renders the claim indefinite. The term "may be selected" is not defined by the claim, it can be considered as "may" or "may not be selected", and the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction is required.

Other dependent claims are also rejected because the deficiencies of their base claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-25, and 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Leclair et al. (U.S. Pub. 2003/0055866 A1).

As to claim 23, Leclair teaches a scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices (an input device or a scanner contains more destination addresses that would like to receive a faxed information, e.g., [0038]-[0039]) may be selected to receive data from an input peripheral having a scanning capability (an input device such as a scanner or fax sends a request to a destination device notifying that input data from the scanner is ready to be transmitted, e.g., [0009]-[0010]);

the input peripheral notifying a selected destination device that the device has been selected to receive data (The input device notifies a destination device that new data is ready to be received. If the destination device accepts the data, the destination device gets, or "pulls," the data from the input device, e.g., [0021]);

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (the destination can request the contained information from the input device or scanner such as image characteristics, file size, and other information about the data. Other information may include, for example, image resolution, image size, and image format (e.g. .jpg, .gif, or compressed). Input device 650 and client 600 may exchange a series of queries for information about the data and the capability of the destination device, e.g., [0040], and if the request is accepted by the destination device, the destination device starts getting data from the scanner, e.g., [0042], [0053]); and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (the destination is receiving a signal indicating an incoming fax, and status of transmission, e.g., [0038], [0046]).

As to claim 24, Leclair teaches the method wherein the input peripheral comprises a scanner or a multifunction peripheral (e.g., [0034]).

As to claim 25, Leclair teaches the method further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a

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resource on the selected destination device selected to receive data from the input peripheral (from the input device/scanner/fax, the user can input various network addresses, a fax number (a resource) of the selected destination to transmit data, e.g., [0038]-[0039], and [0042], [0053]).

As to claim 27, Leclair teaches scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (an input device or a scanner contains more destination addresses that would like to receive a faxed information. From the input device/scanner/fax, the user can input various network addresses, a fax number (a resource) of the selected destination to transmit data, e.g., [0038]-[0039], and [0042], [0053]) may be selected to receive data from an input peripheral having a scanning capability (an input device such as a scanner or fax sends a request to a destination device notifying that input data from the scanner is ready to be transmitted, e.g., [0009]-[0010]);

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (The input device notifies a destination device that new data is ready to be received. If the destination device accepts the data, the destination device gets, or "pulls," the data from the input device, e.g., [0021]);

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (the destination can request the contained information from the input device or scanner such as image characteristics, file size, and other information about the data. Other information may include, for example, image resolution, image size, and image format

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(e.g. .jpg, .gif, or compressed). Input device 650 and client 600 may exchange a series of queries for information about the data and the capability of the destination device, e.g., [0040], and if the request is accepted by the destination device, the destination device starts getting data from the scanner, e.g., [0042], [0053]); and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (the destination is receiving a signal indicating an incoming fax, and status of transmission, e.g., [0038], [0046]).

As to claims 28-31, they are the equivalent claims to method claims 23-25, and 27 respectively and are rejected under a similar rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leclair et al. (U.S. Pub. 2003/0055866 A1) in view of Neumann et al. (U.S. Patent No. 6,744,761 B1).

As to claim 26, Leclair teaches the method wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data (note the rejection of claim 25 above); however, Leclair does not show an email address to send the data. Neumann clearly teaches a resource destination address may include a DN, an e-mail address an identifier for a

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corporate resource, such as, for example, video conferencing facilities, a page number, a cellular ~~phone number~~ an identifier for a ~~link~~ machine, or any other similar suitable identifier that can be used to route an incoming media stream to a corporate resource (e.g., col. 8 lines 19-29). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have the multiple types of the destination resource of Neumann in the input device of Leclair to increase the flexibility and assurance when sending data to the selected destination.

Response to Arguments

7. Applicant's arguments with respect to claims 23-31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Minato (U.S. Pub. 2002/0027675 A1) teaches multiple destinations, scanner, and acknowledgment from the selected destination (pages 1-16 and figs. 19A-41).

Witt et al. (U.S. Pub. 2003/0046445 A1) teach scanner, directly sending data to the selected destinations, and confirmations (pages 1-3 and figs. 2-4).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Truc T. Chuong whose telephone number is 571-272-4134. The examiner can normally be reached on M-Th and alternate Fridays 8:30 AM - 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Truc T. Chuong

07/07/05


BA HUYNH
PRIMARY EXAMINER